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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,390	11/20/2003	Kevin W. Bennett	SP03-006	2555
22928	7590	07/12/2005	EXAMINER	
CORNING INCORPORATED			ROJAS, OMAR R	
SP-TI-3-1			ART UNIT	
CORNING, NY 14831			PAPER NUMBER	
			2874	

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/719,390

Applicant(s)

BENNETT ET AL.

Examiner

Omar Rojas

Art Unit

2874



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1103.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Action.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The prior art documents submitted by applicant in the Information Disclosure Statement(s) filed on November 20, 2003 have all been considered and made of record (note the attached copy of form(s) PTO-1449).

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include any of the reference sign(s) mentioned in the description. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The abstract of the disclosure is objected to because the last sentence is grammatically incorrect. Correction is required. See MPEP § 608.01(b).

***Claim Objections***

4. Claim 3 is objected to because of the following informalities: Claim 3 uses the word “optionally” and, therefore, makes the recited limitations indefinite. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Because the drawings lack any of the reference numerals described in the specification, it would require undue experimentation to make or use the claimed invention.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Patent No. 6,546,180 B1 to Koyano et al. (hereinafter “Koyano”).**

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Regarding claim 1, Koyano discloses a dispersion compensation module for optical communication comprising: a take-apart cassette (see Figures 14-15) having

(i) a first part with a first and a second shaped structure (60, 66) of selected height and thickness therein, said first shaped structure 66 being located within said second shaped structure 60, and

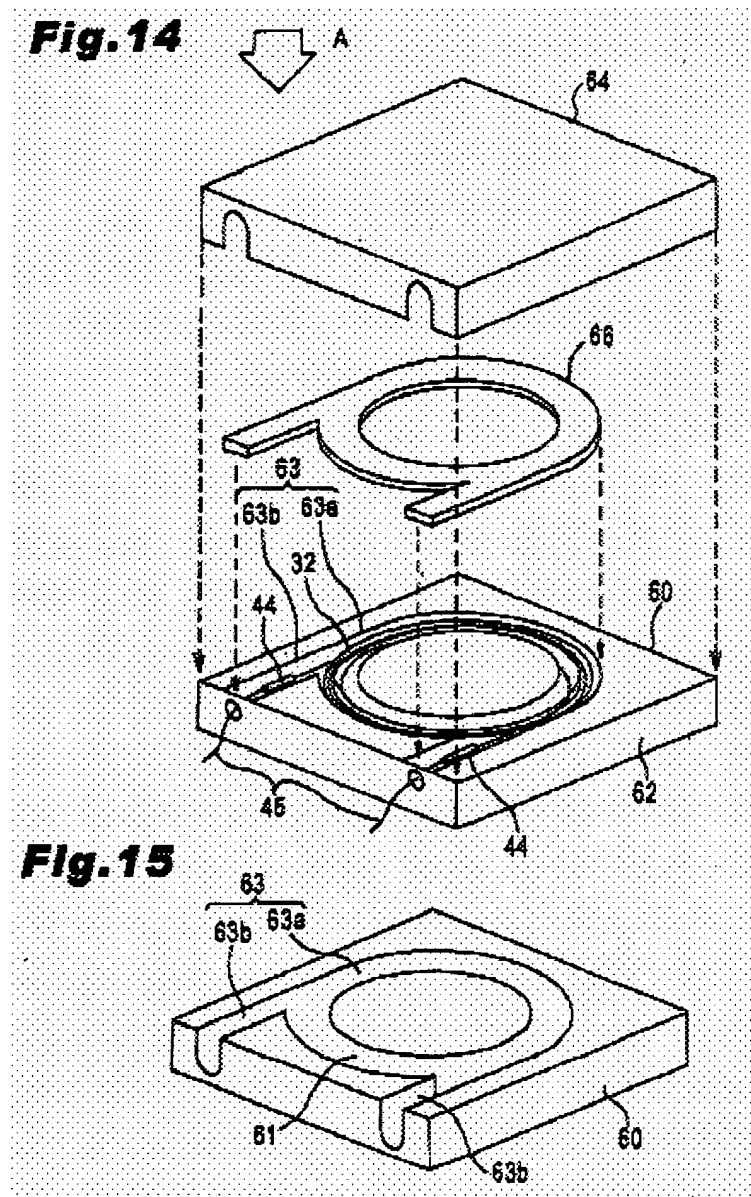
(ii) a second part 64, said second part 64 being a lid for said first part;

(iii) a coil of optical fiber 32 having a first end and a second end, said coil 32 being between said first and second shaped structures (60, 66);

and said first and second end of said coil 32 being connected to a first and a second pigtail 45, respectively; said pigtails 45 being located at the outer perimeter of said cassette for connecting said coil of optical fiber 32 within said cassette to an optical communication system;

wherein said second shaped structure 60 has at least two openings 63b there through for passage of the first and second ends of said fiber coil 32 to said first and second pigtails 45, respectively.

See also column 13, lines 1-35 of Koyano. Figures 14 and 15 of Koyano are reproduced below.



Regarding claim 4, Koyano discloses the recited limitations in column 9, lines 22-28.

Regarding claim 5, the first shaped structure 66 has a circular opening (see Fig. 14) and the second shaped structure 60 has a circular groove 63a. Therefore, both structures (60 and 66) may be considered “circular structures.”

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koyano as applied to claim 1 above, and further in view of Patent No. 6,533,205 B1 to Kles.**

Koyano discloses the claimed invention except that Koyano uses circular shapes instead of elliptical shapes. Kles shows that elliptical shape is an equivalent structure known in the art. Kles at column 7, lines 3-6. Therefore, because these two shapes were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute an elliptical shape for the circular shape of Koyano.

***Allowable Subject Matter***

11. Claims 2, 3, and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and provided that the 112, 1<sup>st</sup> paragraph rejection is overcome.

12. The following is a statement of reasons for the indication of allowable subject matter: Regarding claims 2-3 and 7, it is the examiner's position that it would not have been considered obvious in Koyano to provide an additional resilient material in combination with his first and second shaped structures (60 and 66) and the lid 64. This is because the shaped structures (60 and 66) in Koyano are made of cushiony material and, therefore, are already resilient.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar Rojas whose telephone number is (571) 272-2357. The examiner can normally be reached on Monday-Friday (7:00AM-3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rod Bovernick, can be reached on (571) 272-2344. The official facsimile number for regular and After Final communications is (703) 872-9306. The examiner's RightFAX number is (571) 273-2357.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Omar Rojas  
Patent Examiner  
Art Unit 2874

or  
July 11, 2005